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OFFICE OF PETITIONS

In re Application of
Yang, et al
Application No. 09/998,773
Filed: 30 November, 2001
Attorney Docket No. 2039.010300

DECISION ON PETITION

This is a decision on the petition under ¶(a) of 37 C.F.R. §1.47,¹ filed on 12 May and supplemented on 22 August, 2002

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted (with fee) within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. Any response (with fee) should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)" and may include an oath or declaration executed by the inventor.

Thereafter there will be no further reconsideration.

Failure to respond within the time set forth above will result in abandonment of the application.

BACKGROUND

The record indicates:

- the application was filed on 30 November, 2001, without a fully executed oath or declaration;

¹ The regulations at 37 C.F.R. §1.47 provide:

§1.47 Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in §1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in §1.17(h), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

(c) The Office will send notice of the filing of the application to all inventors who have not joined in the application at the address(es) provided in the petition under this section, and publish notice of the filing of the application in the *Official Gazette*. The Office may dispense with this notice provision in a continuation or divisional application, if notice regarding the filing of the prior application was given to the nonsigning inventor(s).

[47 Fed. Reg. 41275, Sept. 17, 1982, effective Oct. 1, 1982; 48 Fed. Reg. 2709, Jan. 20, 1983, effective Feb. 27, 1983; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Nov. 7, 2000]

- accordingly, a Notice to File Missing Parts of Application was mailed on 25 January, 2002, requiring an executed oath or declaration, and a surcharge for the late filing, all due (absent extension of time) on or before 25 March, 2002;
- Counsel filed on 13 May, 2002, *inter alia*, the surcharge and a request and fee for a two-(2-) month extension of time, and the instant petition (with fee) to prosecute the application with/and the oath or declaration signed by less than all of the inventors on behalf of the non-signing inventors Kevin Cai (Mr. Cai) and Lennard Torres (Mr. Torres);
- the petition recited that the non-signing inventors could not be contacted, but, *inter alia*, appears to recite an incorrect mail address for Mr. Cai and the record demonstrates that the entire application was not sent² to Mr. Cai and Mr. Torres--of which condition Counsel was made aware via telephone on 22 August, 2002 in order that she might evidence that Mr. Cai and Mr. Torres had been presented (or that attempts had been made to present them) with the complete application, yet they refused to sign or cannot be found or reached after diligent effort.

ANALYSIS

Petitioner has failed to establish that the inventors have been presented with the full application and have refused to sign the declaration (the proof of the pertinent events must be made by a statement of someone with first hand knowledge of the events with support of the registered practitioner prosecuting this matter) or cannot be reached.

A copy of the entire application must be sent to the last known address of the non-signing inventors with a request that he/she sign the declaration for the patent application. A forwarding address should be requested, if the papers are returned, and other attempts to locate the inventor, e.g. through e-mail or the telephone continue to fail, then applicant will have established that the inventor cannot be reached.

Alternatively, an oath or declaration for the patent application in compliance with 37 C.F.R. §§1.63 and 1.64 must be presented. The declaration must set forth the inventor's residence, citizenship and post office address. An oath or declaration in compliance with 37 C.F.R. §§1.63 and 1.64 signed by the Rule 1.47 applicant is required.³

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner of Patents and Trademarks
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

² The copies of the transmittal letters clearly indicate that only the oath or declaration was sent, and not the entire application as required by statute and regulation.

³ See: MPEP 409.03(b).

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



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